



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*OK*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/149,721	09/08/98	MUMPER	R 237/023

LYON & LYON  
633 WEST FIFTH STREET  
SUITE 4700  
LOS ANGELES CA 90071-2066

HM12/0219

EXAMINER

OWENS JR, H

ART UNIT	PAPER NUMBER
----------	--------------

1623

*4*

DATE MAILED: 02/19/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/149,721**

Applicant(s)  
**Mumper et al.**

Examiner  
**Howard Owens**

Group Art Unit  
**1623**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-40 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

*Election/Restriction*

- 5 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-9, drawn to a compound, classified in class 536 , subclass 17.2.
  - II. Claims 10-30, drawn to a composition, classified in class 514, subclass 25 and  
Claims 31-35, drawn to a method of delivering macromolecules, classified in class ,  
subclass 25.
  - 10 III. Claims 36, 38 and 39, drawn to a method of synthesizing a compound, classified in  
class 536, subclass 18.6.
  - IV. Claims 37 - 40, drawn to a method of synthesizing a compound, classified in class  
536 , subclass 18.5.

The inventions are distinct, each from the other because of the following reasons:

- 15 Inventions I and II are related as product and process of use. The inventions can be  
shown to be distinct if either or both of the following can be shown: (1) the process for using the  
product as claimed can be practiced with another materially different product or (2) the product  
as claimed can be used in a materially different process of using that product (MPEP  
§ 806.05(h)). In the instant case, the process for delivering one or more macromolecules into one  
20 or more cells may be practiced with another materially different product such as liposome  
derivatives.

Inventions I and III and I and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process as applicant claims two methods in the instant application for making the compound of Claim 2. In the event applicants elect the invention of Group I, **one** of the methods for synthesizing a compound from either Group III or Group IV will be examined along with Group I.

The inventions of Group II and III and Group II and IV are distinct as one of skill in the art would recognize that the search required for a method of synthesizing a compound would propose a search divergent from that required for a method of delivering macromolecules to a cell. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Groups III and IV, restriction for examination purposes as indicated is proper.

Inventions of Group III and Group IV are seen as two distinct methods of synthesizing the same compound as such restriction to one method is deemed proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the searches

Art Unit 1623

required for inventions of Groups I-IV are so varied and numerous that they would impose an undue burden upon the examiner in charge of this application, restriction for examination purposes as indicated is proper. restriction for examination purposes as indicated is proper.

5 This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1 - claims 20 - 22, class 536, subclass 23.1

Species 2 - claims 23, 24 and 28, class 424

Species 3 - claim 27, class 424, subclass 70.15

10 Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 11 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,  
15 including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

Art Unit 1623

of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Because these species are distinct and have acquired a separate status in the art because of their recognized divergent subject matter and the searches required for Species 1-3 are so varied that they would impose an undue burden upon the examiner in charge of this application, election for examination purposes as indicated is proper.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

A telephone call was made to Charles Berkman on 2/8/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

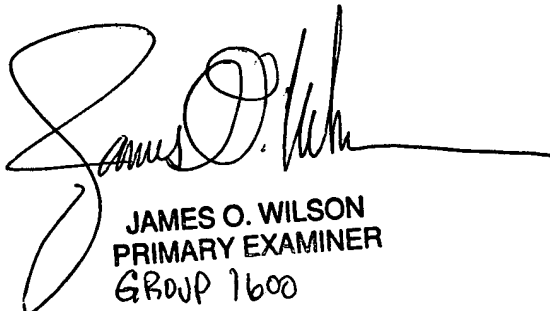
Art Unit 1623

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538. The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Primary Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
JAMES O. WILSON  
PRIMARY EXAMINER  
GROUP 1600